

## REMARKS

Claims 1-7 are pending in the subject application. Claim 7 has been canceled herein. Support for the amendments is found throughout the specification as filed and no new matter is added by these amendments.

Favorable reconsideration in light of the remarks which follow is respectfully requested.

### 1. 35 U.S.C. §103 Rejections

Claims 1-6 have been rejected under 35 U.S.C. §103(a) as being unpatentable over JP 2000-272935 (JP '935) in view of either one of "Photoresponsive Formation of Gold Particles in Silica/Titania Sol'Gel films" by Yanagi et al. (Yanagi) or JP 6-191896 (JP '896) for the reasons set forth in paragraph 6 of the Office Action dated 5/7/03.

Applicants respectfully traverse.

Applicants enclose herewith a translated priority document of JAPAN H11(99)-302265, from which the present application claims priority. As clearly shown, the priority of the present application is October 25, 1999, while JP '935 was published on October 3, 2000. Thus, JP '935 does not qualify as prior art.

Yanagi uses  $\text{Ti}(\text{OC}_2\text{H}_5)_4$  as the Ti component and  $\text{Si}(\text{OC}_2\text{H}_5)_4$  as the Si component. The coated film is irradiated with UV and subjected to heat at 150-450°C for up to 80 minutes. Yanagi does not describe or suggest the use of titanium oxide microparticles as required by Applicants' claims.

JP '896 uses  $\text{Ti}(\text{OCC}(\text{CH}_3)_2)_4$  as the Ti component and  $\text{Si}(\text{OC}_2\text{H}_5)_4$  as the Si component in Examples 5, 7, 8, 10 and 11. The coated film is irradiated with UV and then subjected to heat at 600°C for about 6 minutes. JP '896 does not describe or suggest the use of titanium oxide microparticles as required by Applicants' claims. Applicants note, in particular, that JP '896 uses titanium oxide raw material, while Applicants use titanium oxide micro-particles. The use of titanium oxide micro-particles in the present invention causes the difference in the optical characteristics of

exposed regions and unexposed regions and causes the transmission color tone or transmitted light spectrum to vary.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 2142.

As set forth above, the cited references do not teach or suggest all the claim limitations. Further, JP '935 does not qualify as prior art. Thus, claim 1 is patentable over Yanagi and JP '896. Claims 2-6 depend from claim 1 and, likewise, are patentable over Yanagi and JP '896.

### **CONCLUSION**

Reconsideration and allowance of claims 1-6 is respectfully requested in view of the foregoing discussion. This case is believed to be in condition for immediate allowance. Applicant respectfully requests early consideration and allowance of the subject application.

Applicants believe that no extension of time is required since this response is being filed before the expiration of the specified time period. Applicants, however, conditionally petition for an extension of time to provide for the possibility that such a petition has been inadvertently overlooked and is required. As provided below charge Deposit Account No. **04-1105** for any required fee.

Should the Examiner wish to discuss any of the amendments and/or remarks made herein, the undersigned attorney would appreciate the opportunity to do so.

Respectfully submitted,



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